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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,951	12/03/2003	Yoshiyuki Kikuchi	9281/4733	4363

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EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/726,951

Applicant(s)

KIKUCHI ET AL.

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8, 10-20, 23 and 25-50 is/are rejected.
- 7) ☒ Claim(s) 4, 7-9 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/19/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 (out of 58 total) of U.S. Patent No. 6,681,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set of claims teach an input device comprising: in input/output port; a first pointing device coupled to an input of the input/output port and a second pointing device coupled directly to the input of the input/output port; wherein the input/output port has a single output channel through which data is transferred from the first pointing device and the second pointing device to a driver that resides on a host, and wherein said first pointing device and said second pointing device can transmit a fixed length data stream of three bytes and at least one of

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said first pointing device and said second pointing device can transmit a fixed length data stream of six bytes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5, 6, and 8, are rejected under 35 U.S.C. 102(b) as being anticipated by Bertram et al., (US 5,613,137).

As per claim 5, Bertram teaches a personal computer (game) system comprising:

a first input device;

a second input device;

an output means for outputting operation signals from said first input device and

from said second input device in a variable length signal format; and

a processing unit (12) that alternates between the signals in accordance with an

operation of each of said first input device and said second

input device,

wherein said output means adds an identifier selected portions of the operation signals that distinguishes the input devices. (Abstract, col. 5, lines 58-col. 6, lines 1-2, col. 15, lines 13-col. 18, lines 1-65)

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As per claim 6, Bertram inherently teaches wherein said first input device outputs variable information on X, Y, and Z three-dimensional coordinates, and said second input device outputs variable information on X and Y two-dimensional coordinates, and where said second input device outputs variable information on X and Y two-dimensional coordinates, and when said second device is used, said identifier is added to a Z-information field of the signal format output from said output device.

Claim 5, 6, and 8, are rejected under 35 U.S.C. 102(b) as being anticipated by Bertram et al., (US 5,613,137).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 19, 20, 23, 25-33, 42-46, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertram et al., (US 5,613,137).

As per claim 1, 19, 20, 42-46, 47, 49, and 50, Bertram teaches a personal computer game system comprising:

a plurality of different types of coordinate input devices;

an output means for outputting a signal from each of said coordinate input devices, the output means configured to embed an identifier in the signal that identifies one of the coordinate input devices; and (col. 16, lines 20-28);

a processing means (12) for alternating between the signals from said coordinate input devices as the signals are transmitted to the output means, said signals consisting of a first and a second data stream of three or six bytes;

wherein a cursor displayed on a screen of said personal computer can be maintained at a constant position as one coordinate input device changes to another coordinated input device.

Bertram teaches a personal computer game system with an input device comprising a joystick input, an overlay sensor, and a touchpad, wherein each input device has a different signal packets that allows the processing means to recognize and alternate between the different received signal packets of the input device. Bertram teaches wherein the signal packet consists of a first and second data stream of three bytes (joystick, touchpad). (See Table, col. 17) It is obvious to one of ordinary skill at the claim language is presented in alternative language requiring one "or" the other be found not necessarily both. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that Bertram teaches Bertram teaches an embed signal packet consisting of three bytes. (Abstract, col. 5, lines 58-col. 6, lines 1-2, col. 15, lines 13-col. 18, lines 1-65)

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As per claim 2, Bertram teaches a personal computer game system comprising:

a first input device; (joystick, Fig. 3)

a second input device (touchpad, Fig. 3), said input device performing a detecting operation in a manner differing from said first input device; and output configured to send an output signal from said first input device or said second input device, from said first input device and from said second input device in a three or six byte data stream, whereby said first input device and said second input device transmit signal in an alternating sequence from the first input device and the second input device. (Abstract, col. 5, lines 58-col. 6, lines 1-2, col. 15, lines 13-col. 18, lines 1-65)

As per claim 3, Bertram teaches wherein said first input device outputs absolute coordinate data and/or relative coordinate data, and said second input device outputs relative coordinate data.

As per claim 23, 33-36, and 38, Bertram teaches a dual pointing device used to control a cursor in a computer game system. Bertram teaches the use of a relative pointing device, i.e. joystick, and a relative/absolute pointing device, i.e. touchpad, but does not expressly teach of a stick. However, it would have been obvious to one of ordinary skill at the time the invention was made that the joystick of Bertram performs the same functions as a stick input because both provides the system with a relative (two dimensional) coordinates. Further, it would have been obvious that the joystick and

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touchpad comprises a sensor that moves the cursor in a direction of a pressure placed upon it.

As per claims 25 and 26, Bertram does not teach wherein the computer game system comprises a notebook, however, notebook computers are well known in the art thereby making use of this type of computer obvious.

As per claims 27-32, Bertram obvious teaches a first and buffer that temporarily stores the relative or absolute data before transferring the stored data to the computer in a data length of three bytes. (See Fig. 3)

As per claims 37, 39, 40, and 41, Bertram does not clearly teaches wherein the serial port is bi-directional, however, bi-directional serial ports are well known in the art thereby making use of this type of serial port obvious to one of ordinary skilled in the art.

Claims 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Du et al.*, (US 5,856,822).

As per claim 20, Du teaches a dual pointing device comprising:

- a single input/output port (272, Fig. 5);
- a first pointing device (20 or 278, Fig.5) comprising a first relative pointing device and an absolute point device coupled to an input of the input/output; and



- a second pointing device (20 or 278, Fig.5) comprising a second relative pointing device coupled to the input of the input/output port and a format device configured to send identifying data to a driver that identifies the first and second relative pointing devices;
- wherein the input/output port has a single output channel (272, Fig.5) through which data is transferred from the first pointing device and the second pointing device to a driver coupled to the first pointing device and the second pointing device and wherein the first and second pointing devices further comprise cursor-control devices that can control a position of a cursor simultaneously. (Abstract, col. 10, lines 19-47, Figs. 1-5)

*Du* teaches of comprising a pointing device having a first relative pointing device and an absolute point device and another pointing device comprising a second relative pointing device coupled to the input of the input/output port. It would to one of ordinary skill that both pointing devices are coupled to the input/output and one is directly coupled to the input/output port. *Du* discloses wherein the first and second pointing devices further comprise cursor-control devices that can control a position of a cursor simultaneously. Specifically, *Du* point out that both input devices – touch pad and mouse - attempt to provide input data simultaneously, input data from one input device takes precedence over the other device. It would have been obvious that *Du* teaches the code to control a cursor simultaneously, meaning, *Du* discloses wherein if an absolute coordinate inputted by the touch pad is currently controlling the cursor and then a relative coordinate is inputted by the mouse, either signal can control the cursor simultaneously depending

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the sequence of the inputted signal. *Du* teaches of a dual pointing device comprising first and second pointing devices. It would have been obvious to one of ordinary skill at the time the invention was made that *Du* teaches of distinguishing between signals received from the first and second pointing devices to a driver, because *Du* teaches of determining which signals currently inputted takes precedence over the other device.

#### ***Allowable Subject Matter***

Claim 4, 7-9, and 24, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00

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from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

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Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT" or "OFFICIAL") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window

Crystal Plaza Two, Lobby Room 1B03, Arlington, VA, 22202 Crystal Park II, 2121:



Tammara Peyton

August 23, 2004